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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,972	08/29/2001	Yoshihide Murakami	213338	7743
23460	7590	02/23/2005	EXAMINER	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6780			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,972

Applicant(s)

MURAKAMI ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-9,12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-9,12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Amendment filed on 11/22/04 is sufficient to remove the rejection under 35 USC § 102 (b)/103 (a) over Otsuka et al (U.S. 4,608,249) as applied to claims 1 & 9 (08/16/04, paragraph no. 4) and the rejection under 35 USC 103 (a) over Otsuka et al (U.S. 4,608,249) in combination with Muraoka et al (U.S. 5,876,745) or Muraoka et al (U.S. 6,139,867) as applied to claims 2-8 & 10-16.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 6 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "glycerine ester of saturated fatty acid" per claims 6 & 14 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis. It is suggested that applicant replace "glycerine" with "triglycerine" so as to avoid any confusion.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4, 6-9, 12 & 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 & 10-14 of U.S. Patent No. 6,787,681 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the adhesive layer mainly comprised of an acrylic polymer, a component compatible with the acrylic polymer and liquid or pasty at ordinary

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temperature which includes a carboxylic acid ester such as glyceryl monocaprylate, glyceryl tricaprylate, glyceryl trilaurate, glyceryl triisostearate and glyceryl trioleate and a chemical crosslinking agent such as an isocyanate compound and an organic peroxide per the claims of U.S. Patent '681 overlaps in scope with the adhesive composition for application to skin which comprises an acrylic copolymer(100 parts by weight) obtained from a monomer mixture comprising a (meth)acrylic acid alkyl ester monomer(40 to 80 wt %), an alkoxy group-containing ethylenically unsaturated monomer(10 to 60 wt %) and a carboxy group-containing ethylenically unsaturated monomer(1 to 10 wt %) and a triglycerine ester of a saturated fatty acid having 8 to 10 carbon atoms (20 to 120 parts by weight) which is liquid or paste at room temperature, wherein the acrylic copolymer has a gel fraction of 30 to 80 wt % per the instantly claimed invention with the understanding that the acrylic copolymer of U.S. Patent '681 meets the acrylic copolymer of the instantly claimed invention as expressly taught at col. 4, lines 58-67, col. 5, lines 1-19 & 38-67 and col. 6, lines 1-3 of U.S. Patent '681. Furthermore, the contents of the acrylic copolymer and the monomer components making up the acrylic copolymer per U.S. Patent '681 are generic and therefore necessarily imply that any content, including the claimed contents, would have been operable within the scope of the claimed invention. As to the gel content, such would be considered to be an inherent property of the acrylic copolymer of the claims of U.S. Patent '681, as modified or not to involve anything unobvious.

6. Claims 1, 4, 6-9, 12 & 14-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5 & 10 of copending Application No. 10/443,844.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the adhesive layer formed from a resin composition comprising an acrylic acid ester polymer, a carboxylic acid ester having 16 or more carbon atoms which is compatible with said acrylic acid ester polymer and is liquid or paste at ordinary temperature and a crosslinking agent per the claims of copending application '844 overlaps in scope with the adhesive composition for application to skin which comprises an acrylic copolymer(100 parts by weight) obtained from a monomer mixture comprising a (meth)acrylic acid alkyl ester monomer(40 to 80 wt %), an alkoxy group-containing ethylenically unsaturated monomer(10 to 60 wt %) and a carboxy group-containing ethylenically unsaturated monomer(1 to 10 wt %), a triglycerine ester of a saturated fatty acid having 8 to 10 carbon atoms (20 to 120 parts by weight) which is liquid or paste at room temperature, wherein the acrylic copolymer has a gel fraction of 30 to 80 wt % per the instantly claimed invention with the understanding that the acrylic copolymer and

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carboxylic acid ester having 16 or more carbon atoms of copending application '844 meet the acrylic copolymer and triglycerine ester of the instantly claimed invention as expressly taught at pages 11 & 12 and page 14, lines 6-22, respectively, of copending application '844. Furthermore, the contents of the acrylic copolymer and the monomer components making up the acrylic copolymer per copending application '844 are generic and therefore necessarily imply that any content, including the claimed contents, would have been operable within the scope of the claimed invention. As to the gel content, such would be considered to be an inherent property of the acrylic copolymer of the claims of copending application '844, as modified or not to involve anything unobvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments filed 11/22/04 have been fully considered but they are not persuasive.

Relative to the OTDP Rejection----The Obviousness-type double patenting rejection of claims 1,4, 6-9, 12 & 14-16 over claims 1 & 10-14 of U.S. Patent 6,787,681 B2 (U.S. copending 10/317,076) set forth supra is deemed proper, herein maintained and necessitates an acceptably filed Terminal Disclaimer so as to remove this rejection.

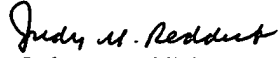
Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571) 272-1110. The examiner can normally be reached on 6:00 a.m. - 2:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
02/21/05